

Mail Stop Interference  
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Paper 10  
Filed: 20 October 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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ROBERT S. **HARP** and DAVID J. RAY  
Junior Party  
(Patent 5,524,479),

v.

CRAIG B. **PRATER**, JAMES MASSIE, DAVID A. GRIGG,  
VIRGIL B. ELINGS, and PAUL K. HANSMA  
Senior Party  
(Application 08/871,029).

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Patent Interference No. 105,783 (SCM)  
(Technology Center 2800)

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**DECLARATION – Bd.R. 203(b)<sup>1</sup>**

1       **Part A. Declaration of interference**

2       An interference is declared (35 U.S.C. § 135(a)) between the above-  
3       identified parties. Details of the application(s), patent (if any), reissue

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<sup>1</sup> “Bd.R. x” may be used as shorthand for “37 C.F.R. § 41.x”. 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).



1 application (if any), count(s) and claims designated as corresponding or as not  
2 corresponding to the count(s) appear in Parts E and F of this DECLARATION.

3 **Part B. Judge managing the interference**

4 Administrative Patent Judge Sally C. Medley has been designated to  
5 manage the interference. Bd.R. 104(a).

6 **Part C. Standing order**

7 A Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
8 DECLARATION. The STANDING ORDER applies to this interference.

9 **Part D. Initial conference call**

10 A telephone conference call to discuss the interference is set for **1:30 p.m.**  
11 **on 16 December 2010** (the Board will initiate the call).

12 No later than **four business days** prior to the conference call, each party  
13 shall file and serve (SO ¶¶ 10.1 & 105) a list of the motions (Bd.R. 120;  
14 Bd.R. 204; SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

15 A sample schedule for taking action during the motion phase appears as  
16 Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the  
17 schedule prior to the conference call and to agree on dates for taking action. A  
18 typical motion period lasts approximately eight (8) months. Counsel should be  
19 prepared to justify any request for a shorter or longer period.



1       **Part E. Identification and order of the parties**

2                               Junior Party

3       Named Inventors:       ROBERT S. **HARP**, Westlake, CA  
4                               DAVID J. RAY, Agoura Hills, CA  
  
5       Involved Patent:       Patent 5,524,479, issued 11 June 1996, based on  
6                               Application 08/377,191, filed 24 January 1995  
  
7       Title:                 DETECTION SYSTEM FOR SCANNING  
8                               MICROSCOPES  
  
9       Assignee:             Quesant Instrument Corporation  
10

11                               Senior Party

12       Named Inventors:       CRAIG B. **PRATER**, Santa Barbara, CA  
13                               JAMES MASSIE, Santa Barbara, CA  
14                               DAVID A. GRIGG, Santa Barbara, CA  
15                               VIRGIL B. ELINGS, Santa Barbara, CA  
16                               PAUL K. HANSMA, Santa Barbara, CA  
17  
  
18       Involved Application:   Application 08/871,029, filed 9 June 1997  
  
19       Title:                 SCANNING STYLUS ATOMIC FORCE  
20                               MICROSCOPE WITH CANTILEVER  
21                               TRACKING AND OPTICAL ACCESS  
  
22       Assignee:             None  
23

24       The senior party is assigned exhibit numbers 1001-1999. The junior party  
25       is assigned exhibit numbers 2001-2999. Bd.R. 154(c)(1); SO ¶ 154.2.1. The  
26       senior party is responsible for initiating settlement discussions. SO ¶ 126.1.



1       **Part F. Count and claims of the parties**

2                               Count 1

3                               Claim 7 of Harp Patent 5,524,479

4                               Or

5                               Claim 56 of Prater Application 08/871,029

6       The claims of the parties are:

7               Harp:        1-31

8               Prater:     42-72 and 74-77

9       The claims of the parties which correspond to Count 1 are:

10              Harp:       1-10, 12-21 and 23-31

11              Prater:     42, 45-48, 50-72 and 74-77

12       The claims of the parties which do not correspond to Count 1 are:

13              Harp:       11 and 22

14              Prater:     43, 44 and 49

15       The parties are accorded the following benefit for Counts 1-3:

16              Harp:       Application 08/801,084<sup>2</sup>, filed 14 February  
17                               1997, now RE37,404 E, issued 9 October 2001

18                               Application 08/137,625, filed 15 October 1993,  
19                               now Patent 5,388,452, issued 14 February 1995

20              Prater:     Application 08/107,017, filed 17 August 1993,  
21                               now Patent 5,463,897, issued 7 November 1995

22                               Application 08/416,100, filed 4 April 1995,  
23                               now Patent 5,560,244, issued 1 October 1996

24                               Application 08/679,332, filed 11 July 1996,  
25                               now Patent 5,714,682, issued 3 February 1998  
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<sup>2</sup> Application 08/801,084 is a reissue of Application 08/137,625.



1 Part G. Heading to be used on papers  
2 The following heading must be used on all papers filed in this  
3 interference, see SO ¶ 106.1.1:

4 UNITED STATES PATENT AND TRADEMARK OFFICE  
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7 AND INTERFERENCES  
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9  
10 ROBERT S. HARP and DAVID J. RAY  
11 Junior Party  
12 (Patent 5,524,479),

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14 CRAIG B. PRATER, JAMES MASSIE, DAVID A. GRIGG,  
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20 (Technology Center 2800)  
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24 **Part H. Order form for requesting file copies**

25 When requesting copies of files, use of SO Form 4 will greatly expedite  
26 processing of the request. Please attach a copy of Parts E and F of this  
27 DECLARATION with a hand-drawn circle around the patents and applications  
28 for which a copy of a file wrapper is requested.

29 /Sally C. Medley/  
30 Administrative Patent Judge



1 Enc:  
2 Copy of STANDING ORDER  
3 Copy of Patent 5,524,479  
4 Copy of claims of Application 08/871,029  
5 PTO-850  
6 Examiner write-up  
7  
8  
9 cc (via overnight delivery):  
10 Attorney for Harp:  
11 Marvin H. Kleinberg, Esq.  
12 2049 Century Park East #1080  
13 Los Angeles, CA 90067-3150  
14  
15 Attorney for Prater:  
16 Patrick F. Bright, Esq.  
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18 633 West Fifth Street, Suite 3330  
19 Los Angeles, CA 90071